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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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34018	7590	10/06/2003		
GREENBERG TRAUIG, P.C. 77 WEST WACKER DRIVE CHICAGO, IL 60601-1732			EXAMINER SAADAT, CAMERON	
			ART UNIT 3713	PAPER NUMBER

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/051,272

Applicant(s)

AU, I. S.

Examiner

Cameron Saadat

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

In response to amendment filed 7/21/03, claims 1-14 are pending in this application.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 2, 4-6, 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by**

**Wisniewski et al. (USPN 5,349,129; hereinafter Wisniewski).**

Regarding claims 1 and 13, Wisniewski discloses an apparatus for determining the identification of selected objects for use in connection with an electronic children's toy, the apparatus comprising: a plurality of objects 10, 12, 14 which include a plurality of object contact elements 32a-e (see Fig. 1), wherein two or more of the contact elements are connected to form a contact pattern which serves to uniquely identify the object (Col. 3, lines 46-59); and an identification member 16, 18, 20 capable of being placed in physical contact with the object contact elements 32a-d; the identification member including a plurality of member contact elements 42, 44, 46, 48, 50 configured such that at least two of the member contact elements 32a-e come into electrical contact with at least two of the object contact elements 42, 44, 46, 48, 50 when the identification member is placed in contact with one of the objects (see Fig. 3a); and a processing unit 70, 72, 74, 76 in electrical contact with the identification member capable of detecting the object contact pattern and determining the identification of the particular object (Col. 3, lines 46-59).

Regarding claims 2 and 14, Wisniewski discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 3, lines 46-59).

Regarding claim 4, Wisniewski discloses an apparatus wherein audio information is provided upon movement of a portion of the apparatus (Col. 1, lines 55-59).

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Regarding claim 5, Wisniewski discloses an apparatus wherein the identification member includes at least three contact elements 42, 44, 46,48, 50 arranged linearly (See Fig. 3a).

Regarding claims 6, Wisniewski discloses an apparatus wherein the objects 10, 12, 14 include at least two contact elements 32a-e arranged such that each of the object contact elements comes into physical contact with a corresponding one of the identification member contact elements 42, 44, 46,48, 50.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 3, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisniewski et al. (USPN 5,349,129; hereinafter Wisniewski) in view of Domiteaux (USPN 5,959,281).**

Regarding claims 3 and 11, Wisniewski discloses an apparatus comprising a means of providing audio information including musical notes, animal sounds, shooting guns, jet engines, or virtually any other electronically reproducible sound (Col. 2, lines 61-66). Wisniewski does not explicitly disclose computer-generated human speech. However, Domiteaux discloses an apparatus 10 for determining the identification of selected objects 1 for use in connection with an electronic children's toy. The apparatus further provides computer-generated human speech (Col. 5, lines 34-37, 43-50). Hence, it would have

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been obvious to a person of ordinary skill in the art to modify the audio described in Wisniewski by providing computer-generated human speech, in light of the teachings of Domiteaux, in order to provide audio information associated with a person, place, or thing.

Regarding claim 9, Wisniewski discloses all of the claimed subject matter with the exception of providing the identification member in the form a fishing pole and a hook member. However, Domiteaux discloses an apparatus 10 for determining the identification of selected toy objects 1. The apparatus further indicates that the toy identification member and toy may be shaped in various forms including a fish and lure (Col. 7, line 43). Hence, in view of Domiteaux, it would have been obvious to a person of ordinary skill in the art to modify the shape of the identification member and the toy object described in Wisniewski, by providing an object identification member that can take the form of various shapes, thereby providing an identification member that is readily modifiable for specific applications (See Domiteaux, Col. 2, lines 33-38).

Regarding claim 10, Wisniewski discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 3, lines 46-59).

Regarding claim 12, Wisniewski discloses an apparatus wherein audio information is provided upon movement of a toy object with respect to the identification member (Col. 1, lines 55-59).

**6. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisniewski et al. (USPN 5,349,129; hereinafter Wisniewski).**

Regarding claim 7, Wisniewski discloses an apparatus wherein the identification member includes at least four contact elements 42, 46, 48, 50 arranged in a linear row. (See Fig. 3a). It is not explicitly disclosed that the contact elements are arranged in two linear rows. However, it would have been an obvious matter of design choice as to the configuration of the contact elements for establishing electrical contact wherein no stated problem is solved or unexpected result is obtained by prescribing two rows of contacts.

Regarding claim 8, Wisniewski discloses an apparatus wherein the objects 10, 12, 14 include at least two contact elements 32a-e arranged such that each of the object contact elements comes into

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physical contact with a corresponding one of the identification member contact elements 42, 44, 46, 48, 50.

***Response to Arguments***

7. Applicant's arguments filed 7/17/03, with respect to the rejection(s) of claim(s) 1-14 have been fully considered and are persuasive. Therefore, the rejection set forth in the office action filed 4/17/03 has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wisniewski and Domiteaux.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Herman et al. (USPN 5,364,272) – disclose a toy comprising conductive pads and a unit for detecting the code pads to provide an output.
- Sakow (USPN 5,346,399) – discloses an educational apparatus including objects with specific pin configurations for insertion into an object identifier receptacle.
- Doederlein et al. (USPN 6,292,780) – disclose an object and object identifier comprising contact elements.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700